

ESTTA Tracking number: **ESTTA457330**

Filing date: **02/17/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194280
Party	Defendant Zero Motorcycles, Inc.
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Date	02/17/2012
Attachments	20120217 - RESPONSE TO TTAB REQUEST FOR STATUS OF CIVIL ACTION - 91194280 - FINAL FILED 3.pdf (3 pages)(71417 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PIRELLI TYRE S.P.A. AND PIRELLI & C. S.P.A.,)	
)	
Opposers,)	Opposition No. 91194280
)	
v.)	Pirelli Tyre S.p.A., Pirelli & C. S.p.A.
)	v.
)	Zero Motorcycles, Inc.
)	
)	Mark: ZERO MX
)	Serial No. 77757810
)	Filed: June 11, 2009
)	Published: March 16, 2010
)	
)	Consolidated Opposition No.
)	91192093
)	
)	Pirelli Tyre S.p.A.
)	v.
)	Zero Motorcycles, Inc.
ZERO MOTORCYCLES, INC.,)	
)	Opposition No. 91192475
)	Cancellation No. 92051520
)	Cancellation No. 92051859
Applicant.)	
)	Pirelli Tyre S.p.A., Pirelli & C. S.p.A.
)	v.
)	Zero Motorcycles, Inc.

RESPONSE TO TTAB REQUEST FOR STATUS OF CIVIL ACTION

Applicant Zero Motorcycles, Inc. hereby responds to the TTAB Attorney's request dated January 18, 2012, for a report regarding the status of the civil action between Applicant and Opposers, filed by Applicant in the Northern District of California and styled Zero Motorcycles, Inc. v. Pirelli Tyre, S.p.A., Case No. 10-01290 SBA.

This case has been dismissed by the District Court, for lack of personal jurisdiction over the Opposers, via Order date July 15, 2011.

However, Applicant has appealed that ruling to the Ninth Circuit Court of Appeal, via Notice of Appeal timely filed on August 17, 2011.

Applicant further has requested that the District Court entertain Applicant's Motion for Relief from the Judgment, filed on January 13, 2012. A hearing date for the motion is set for May 1, 2012. Applicant has also sought an extension of the briefing schedule with the Ninth Circuit Court of Appeals on January 13, 2012. Both motions are submitted and pending.

As a preliminary matter, Applicant notes that it has filed a similar Response to this Board's request for status in Opposition proceeding No. 91192093 on September 8, 2011. The only changes in status since that date are the above-mentioned Motion for Relief and request for extension. Applicant also notes that on June 21, 2010 the instant proceeding was consolidated with Opposition No. 91192093, which was named as the "parent" Opposition number for proceeding Nos. 91192475 and 92051520 on 12/22/09 and 92051859 on 1/25/10. However in the consolidation order for the instant proceeding dated June 21, 2010, the Board named No. 91179281 as the "parent" proceeding. Applicant believes this is a mistake and this proceeding should have been consolidated under parent number 91192093. A query in the TTABVue system of Opposition No. 91179281 resolves to an opposition between Yuri Kuklachev v. Mark Gelfman regarding the mark MOSCOW CATS THEATRE. This is not the instant proceeding. Applicant requests an amended Order of Consolidation for the instant proceeding.

It is clear under the TBMP that when parties to a pending TTAB action are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. TBMP § 510.02(a) *See also* 37 CFR § 2.117 (a) ("Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action . . .").

A proceeding is considered to have been finally determined when a decision on the merits of the case . . . has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. TBMP 510.02 (b). *See, e.g. Softbelly's, Inc. v. Ty, Inc.*, 2002 WL 1844210, *2-3 (TTAB 2002) (finding suspension appropriate because civil action had not been finally determined, even after a final judgment had been entered by a district court, and time to appeal had not elapsed); *George Vais v. Vais Arms, Inc.*, 2004 WL 390936, *1 (TTAB 2004) (granting suspension pending a final disposition in an action filed in the Western District of Texas, including any appeals taken from the decision of the District Court).

Applicant has appealed the decision of the District Court and that appeal is pending. While it is pending, it is premature to lift the suspension of these TTAB proceedings. Therefore, Applicant respectfully requests that the Board maintain the suspension of these proceedings until final disposition of the civil action.

Dated: February 17, 2012

Respectfully submitted,

By: /s/ Mike Rodenbaugh

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REPONSE TO TTAB REQUEST FOR STATUS OF CIVIL ACTION has been served on Virgina L. Carron, counsel for opposing party, by delivering a copy via email to her, per prior agreement with her, at:

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Respectfully submitted,

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